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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,689	07/21/2003	Shaoxing Lu	237687US0	4413

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

12

<b>Office Action Summary</b>	<b>Application No.</b> 10/622,689	<b>Applicant(s)</b> LU ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/11/05 RCE.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,4,10-12,18,19 and 22-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 3,4,10-12,18,19 and 22-34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/14/05, 10/11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

2. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 061105).

3. Rejections of Claims 10-12, 18-19 and 22-34 under double patenting rejections are maintained because the rejections are adequately set forth in paragraphs 3-13, of Paper No. 061105. Applicant's arguments have been fully considered but they are not persuasive because of the same reasons set forth in the rest of this Office action.

### ***Claim Rejections - 35 USC § 102 and 103***

4. Rejection of Claims 3-4 and 10 under 35 USC 102(b) as being anticipated by Wittmann (US 4 822 852) and rejection of Claims 24-26 and 29-30 under 35 USC

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103(a) as being unpatentable over Wittmann are maintained because the rejection is adequately set forth in paragraph 16 of Paper No. 061105. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 2, last paragraph), the instant claims are not necessarily limited to Applicants alleged the structure of B-C-A structure (Alkoxy-Amide-Organosiloxane). In the instant claims, the oxyalkylene units, the amide units and the siloxane units can be arranged in a random way to form a random copolymer. Especially, as mentioned in the previous Office action, there is no indication of any specific linkages among these different units. The copolymer set forth in Claim 3 merely recites a copolymer containing oxyalkylene units, amide units and siloxane units.

For Applicants' argument (Remarks, page 3, 1<sup>st</sup> paragraph to 3<sup>rd</sup> paragraph), note that Wittmann's copolymer can contain polyether block units as indicated in col. 4, line 39 to col. 5, line 15, even when p in formula (I) is 0.

5. Rejection of Claims 3-4 10-12 and 18-19 under 35 USC 102(e) as being anticipated by Lu (US 2004/0001799), rejection of Claims 3-4, 10-12, 18-19 and 22-34 under 35 U.S.C. 102(e) as being anticipated by Lu548 (US 2003/0235548),

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rejection of Claims 3-4, 10-12, 18-19 and 22-34 under 35 U.S.C. 102(e) as being anticipated by Lu553 (US 2003/0235553), rejection of Claims 3-4, 10-12, 18-19 and 22-34 under 35 U.S.C. 102(e) as being anticipated by Hansenne (US 2004/0126336), rejection of Claims 3-4, 10-12, 18-19 and 22-34 under 35 U.S.C. 102(e) as being anticipated by Yu552 (US 2003/0235552), rejection of Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(a),(e) as being anticipated by Tournilhac (US 2003/0072730), rejection of Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferrari188 (US 2003/0170188), rejection of Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(a),(e) as being anticipated by Ferrari348 (US 2003/0068348), rejection of Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu154 (US 2004/0115154), rejection of Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu153 (US 2004/0115153), rejection of Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu912 (US 2004/0120912) and rejection of Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Lu030 (US 2003/0232030) are maintained because the rejections are adequately set forth in paragraphs 15 and 17-27 of Paper No. 061105. Applicant's arguments have been fully considered but

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they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (page 3, 4<sup>th</sup> paragraph 1 to page 5, 2<sup>nd</sup> paragraph), Applicants point out that all of the above rejection involve the same issue (that is, whether the disclosed polymer containing only [ ]z and [ ]y blocks anticipates or renders obvious the claimed polymers having an "R" group in addition to [ ]z and [ ]y blocks. This is not persuasive because, as mentioned above, the copolymer set forth in Claim 3 merely recites a copolymer containing oxyalkylene units, amide units and siloxane units. Furthermore, for example, Lu799 (US 2004/0001799) discloses polymer of formula (I) where X can be an alkylenediyl group contain one or more oxygen atoms, i.e., oxyalkylene. ([0037]-[0043]) Mr. Lu's declaration (paragraph 3) indicates that the claimed copolymer possesses sufficient alkoxylation to provide the polymers with emulsifying activity. (Emphasis added) However, these characteristics are not claimed. Even if claimed, Lu799's polymer should possess similar characteristics because the emulsifying activity depends primarily on the type of the units in the polymer, not the linkages among the units. Mr. Lu's declaration (paragraph 4) alleged that oxyalkylene group "R" in the copolymer of Claim 3 is not part of the [ ]z or [ ]y blocks. However, this is not persuasive because Lu799' polymer does contain siloxane units, oxyalkylene units

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and amide units. Applicants appear to improperly interpret narrowly the units in Lu799's polymer by the process prepared therefrom. For Mr. Lu's declaration (paragraph 6), it appears that the motivation to claim the instant invention is irreverent. Furthermore, Nylon-611/dimethicone copolymer is different from Lu799's polymer because it does not contain oxyalkylene units. Therefore, it is not surprised that Nylon-611/dimethicone copolymer do not have emulsifying activity.

6. The references are lined through in the information disclosure statements because they are duplicates.

7. The references cited in "LIST OF RELATED CASES" filed on October 11, 2005 have been considered, except for the followings: US Application Serial Numbers, 10/538,920, 10/538,924, 11/193,444 and 10/517,390 are not available to Examiners as of the date this Office action was made. Furthermore, Applicants do not provide copies of them.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is


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(571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
December 23, 2005

  
Kuo-Liang Peng  
Primary Examiner  
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